

APR. 25. 2005 3:19PM

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APR 25 2005



Medtronic

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To: Examiner LoAn H. Thanh
Company: U.S. Patent and Trademark Office
Phone:
Fax: 703 872-9306

From: Jeffrey J. Hohenshell
Company:  **Medtronic**
Phone: 763 391 9661
Fax: 763 391 9668

Date: April 25, 2005
**Pages including this
cover page:** 14

Comments: Notification of Loss of Entitlement to Small Entity Status Under 37 C.F.R. § 1.27(g)(2).

IF TELECOPY IS ILLEGIBLE OR ALL PAGES HAVE NOT BEEN RECEIVED, PLEASE CONTACT JO BRECHT AT TELEPHONE (763) 391-9663 IMMEDIATELY.

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NO. 6354 - P. 2/14

APR 25 2005

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Streeter, Richard B. et al

Serial No.: 10/014,699

Filed: 10-26-2001

For: INTRACARDIOVASCULAR ACCESS (ICVATM) SYSTEM

Group Art Unit: 3763

Examiner: Thanh, Loan H.

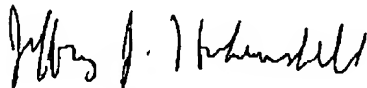
Notification of Loss of Entitlement to Small Entity Status Under 37 C.F.R. § 1.27(g)(2)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The applicant, Medtronic, Inc. is the assignee of the right, title, and interest in the above-identified application, as evidenced by the executed assignment dated December 2004 (copy attached) that was faxed to the United States Patent and Trademark Office on April 25, 2005. The previous owner (assignor) of the above named patent application may have claimed small entity status pursuant to 37 C.F.R. § 1.27(g)(2). Applicant herein provides notice to the United States Patent and Trademark Office that it is not entitled to small entity status and as such requests that the status be changed to that of large entity. Please charge any fees due as a result of this change in entity status to Deposit Account No. 13-2546.

Respectfully Submitted,



Jeffrey J. Hohenshell, Reg. No. 34,109.
710 Medtronic Parkway
Minneapolis, MN 55432

APR. 25. 2005 3:20PM

NO. 6354 P. 3/14

P. 1

* * * COMMUNICATION RESULT REPORT (APR. 25. 2005 11:50AM) * * *

FILE MODE	OPTION	ADDRESS (GROUP)	TTI RESULT	PAGE
6352 MEMORY TX		917033065995	OK	11/11

REASON FOR ERROR
E-1) HANG UP OR LINE FAIL
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E-2) BUSY
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Company: U.S. Patent and Trademark Office
Phone:
Fax: 703 306-5995

From: Jeffrey J. Hohenshell
Company:  **Medtronic**
Phone: 763 301 0001

PAGE 3/14 * RCVD AT 4/25/2005 4:27:20 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID: * DURATION (mm-ss):03-06



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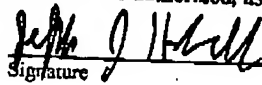
From: Jeffrey J. Hohenshell
Company:  **Medtronic**
Phone: 763 391 9661
Fax: 763 391 9668

Date: April 25, 2005
Pages including this cover page: 10

Comments: Assignment of Patents and applications from Viacor, Inc. to Medtronic, Inc.

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RECORDATION FORM COVER SHEET PATENTS ONLY	
To: The Honorable Commissioner of Patents and Trademarks Please record the attached original document(s) or copy thereof.	
1. Name of conveying party(ies)/(Execution Date) Viacor, Inc. December 2004	Name and address of receiving party(ies): Medtronic, Inc. 710 Medtronic Parkway Minneapolis, Minnesota 55432
Additional names of conveying party(ies) attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No	Additional names of receiving party(ies) attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No
3. Nature of Conveyance: <input checked="" type="checkbox"/> Assignment <input type="checkbox"/> Merger <input type="checkbox"/> Security Agreement <input type="checkbox"/> Change of Name <input type="checkbox"/> Other: If this is a request for correction of a previously recorded document, a copy of the previously recorded assignment and previous Notice of Recordation is enclosed.	
4. Application number or patent number: <input type="checkbox"/> This document is being filed with a new patent application on: _____ <input checked="" type="checkbox"/> This document is to be recorded against the following patent application or patent: <u>10/014,699, filed 10-26-2001</u> <input type="checkbox"/> Patent Cooperation Treaty (PCT): Enter PCT application number <u>only</u> if a U.S. Application Number has <u>not</u> been assigned: _____	
Additional Numbers Attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No	
5. Name and address of party to whom correspondence concerning document should be mailed: Name: Jeffrey J. Hohenshell Medtronic, Inc. 710 Medtronic Parkway Minneapolis, Minnesota 55432 Phone Number: 763-391-9661 Fax Number: 763/391-9668	6. Total number of applications and patents involved: <u>1</u>
	7. Total fee (37 CFR 3.41) <u>\$40.00</u> <input type="checkbox"/> Enclosed <input checked="" type="checkbox"/> Authorized to be charged to deposit account
	8. Deposit Account Number: <u>13-2546</u>
DO NOT USE THIS SPACE	
9. Statement and Signature To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document. Charges to deposit account are authorized, as indicated herein.	
Jeffrey J. Hohenshell Printed Name of Attorney/Agent Registration No. 34,109	 Signature April 25, 2005 Date
Pages: Total number of pages including COVER SHEET, attachments and documents: <u>9</u>	
Mail documents to be recorded with required cover sheet information to: Mail Stop Assignment, Recordation Services, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313	

ASSIGNMENT

THIS ASSIGNMENT (the "Agreement") is made and entered into as of December __, 2004, (the "Effective Date") between Viacor, Inc. ("Assignor"), a Delaware corporation located at 260-B Fordham Road, Wilmington, MA 01887, and Medtronic, Inc. ("Assignee"), a Minnesota corporation located at 710 Medtronic Parkway, Minneapolis, MN 55432.

RECITALS

WHEREAS, Assignor is the owner of the United States and foreign patents and patent applications identified on the attached Exhibit A ("Patents"); and

WHEREAS, Assignee desires to acquire the entire right, title and interest in and to the Patents and in and to the inventions described and claimed therein;

AGREEMENTS:

NOW THEREFORE, in consideration of the representations, warranties, covenants and agreements contained herein, and for other valuable consideration, the receipt and adequacy of which is hereby acknowledged, the parties mutually agree as follows:

1. Specific Definitions. As used in this Agreement, the following definitions and terms shall have the designated meanings:

Redacted

Redacted

2. Assignment. Assignor hereby irrevocably sells, assigns, and transfers to Assignee, and its successors and assigns;

(a) The entire right, title and interest to the Patents including the inventions described or claimed therein, and to each U.S. and foreign patent application and patent from which the Patents claim priority to or from in whole or in part;

(b) The entire right, title and interest to any United States or foreign patents that may issue with respect to the inventions described or claimed in the Patents;

(c) The entire right, title and interest to any renewals, reissues, extensions, substitutions, continuations, continuations-in-part, or divisions of the Patents, and all foreign applications based thereon or foreign counterparts thereof;

(d) The right to apply for patents in foreign countries in its own name and to claim any priority rights to which such foreign applications are entitled under international conventions, treaties or otherwise; and

(e) The right to enforce rights to such Patents as fully and entirely as the same would have been held and enjoyed by the Assignor if this assignment had not been made; together with all claims by Assignor for damages by reason of past infringement or for provisional rights and including the right to sue for, and collect the same for its own use and benefit, and for the use and benefit of its successors, assigns, and other legal representatives.

3. Acknowledgement. Assignor agrees that all Patents shall belong exclusively to Assignee, with Assignee having the right to obtain and to hold in its own name such registrations, patents, or such other perfection, registration, certification, or protection as may be obtained or applicable to the subject matter, and any extensions and renewals thereof. Assignor hereby authorizes and requests the Commissioner of Patents to issue to Assignee any patents that may be granted in accordance with this Assignment. Assignee shall have the sole and exclusive right, in Assignee's absolute discretion and at its sole cost and expense, to exercise complete control over the Patents, including, but not limited to, the right to (a) prosecute any alleged infringement, misappropriation or misuse of the Patents, and (b) apply for, prosecute, or cause the issuance, amendment, abandonment, maintenance, re-examination or reissue of any

patents patent applications included within the Patents. Assignor acknowledges that Assignee has no obligation whatsoever to exploit the Patents or commercialize the underlying inventions or any Covered Products.

4. Further Assurances. Assignor further agrees, for itself and for its successors and assigns, to give Assignee and any person designated by Assignee, at Assignor's expense, reasonable assistance required to perfect, register, certify, and protect the rights defined in this Agreement, to execute and deliver any further applications, assignments or other documents, and to perform such other lawful acts as Assignee its successors and assigns may deem necessary to fully secure, maintain and enforce its rights, title or interest as outlined herein.

5. Payment.

Redacted

6. Offset. If Licensee reasonably determines that sales of Covered Products would be impractical or impossible without obtaining a royalty-bearing license from a third party (a "Necessary License"), then Assignee may enter into a license with such third party. In such event, Assignee shall be permitted to offset fifty percent (50%) of any license fees paid by it to such third party pursuant to the Necessary License against any payments due Assignor under this Agreement; provided, in no event shall the payment due Assignor in a quarter be less than fifty percent (50%) of the amount otherwise owed, absent such offset.

7. Report. Within sixty (60) days after the end of each fiscal quarter of Assignee, Assignee shall provide Assignor with a written report in:

REDACTED

8. Records. Assignee shall maintain, and shall cause its affiliates and licensees to maintain,

true, complete and accurate records (in accordance with generally accepted accounting principles) relating to the rights and obligations under this Agreement and any amounts payable to Assignor in relation to this Agreement, which records shall contain sufficient information to permit Assignor to confirm the accuracy of any reports delivered to Assignor and compliance in other respects with this Agreement. The relevant party shall retain such records for at least four (4) years following the end of the calendar year to which they pertain. Upon reasonable notice and during regular business hours, Assignee shall from time to time (but no more frequently than twice annually) make available such records for audit at Assignor's expense by independent representatives selected by Assignor and reasonably acceptable to Assignee to verify the accuracy of the reports provided to Assignor. Such representatives shall execute a suitable confidentiality agreement reasonably acceptable to Assignee prior to conducting such audit. Such representatives may disclose to Assignor only their conclusions regarding the accuracy and completeness of royalty payments and reports, and of records related thereto, and shall not disclose Assignee's confidential business information to Assignor without the prior written consent of Assignee. In the event that any audit performed under this Section 8 reveals an underpayment in excess of five percent (5%), Assignee shall bear the full cost of such audit and shall remit all amounts due to Assignor (including without limitation, late charges pursuant to Section 5(c)) within thirty (30) days after receiving notice thereof from Assignor.

9. Reassignment. In the event that Assignee intends to abandon the maintenance or prosecution of any U.S. patent or U.S. patent application within the Patents as well as all corresponding patents or patent applications claiming priority to such U.S. patent or U.S. patent application in the Major Markets, then Assignee shall give timely notice (in light of any applicable filing or payment deadlines) to Assignor in writing of such intention and shall offer to assign ownership of any such patent or patent application to Assignor without additional consideration, in which case the costs of controlling, filing, prosecuting and maintaining such patents and patent applications shall be borne by Assignor. For purposes of this Section 9, "Major Markets" shall mean Japan and the countries of the European Union.

10. General Provisions.

- (a) Entire Agreement. This Agreement (including the exhibits) constitutes the entire agreement, and supersedes all prior negotiations, understandings or agreements (oral or written), between the parties about the subject matter of this Agreement. This Agreement may be executed in one or more counterparts, each of which shall be an original, but taken together constituting one and the same instrument. Execution of a facsimile copy shall have the same force and effect as execution of an original, and a facsimile signature shall be deemed an original and valid signature. No waiver, consent or modification of this Agreement shall bind either party unless in writing and signed by the party against which enforcement is sought. The failure of either party to enforce its rights under this Agreement at any time for any period will not be construed as a waiver of such rights. If any provision of this Agreement is determined to be illegal or unenforceable, that provision will be limited or eliminated to the minimum extent necessary so that this Agreement will otherwise remain in full force and effect and enforceable.
- (b) Governing Law. This Agreement shall be governed by and construed in accordance with the laws of the Commonwealth of Massachusetts, without regard to its conflicts of law provisions. In any action or proceeding to enforce or interpret this Agreement, the prevailing party will be entitled to recover from the other party its costs and expenses (including reasonable attorneys' fees) incurred in connection with such action or proceeding and enforcing any judgment or order obtained.

- (c) **Notices.** Any notice or communication hereunder shall be in writing and either personally delivered or sent via confirmed facsimile, recognized express delivery courier or certified or registered mail, prepaid and return receipt requested, addressed to the other party at its address specified above, or at such other address designated in a subsequent notice. All notices shall be in English, effective upon receipt.
- (d) **Binding Effect.** This Agreement shall be binding upon, and inure to the benefit of, the successors, representatives and permitted assigns of the parties.
- (e) **Independent Contractors.** The parties shall be independent contractors under this Agreement, and nothing herein will constitute either party as the employer, employee, agent or representative of the other party, or both parties as joint venturers or partners for any purpose.

IN WITNESS WHEREOF, each of the parties has caused this Assignment Agreement to be executed in the manner appropriate to each.

VIACOR, INC.

By: [Signature]
Its: CEO

MEDTRONIC, INC.

By: _____
Its: _____

GD6VPE&R591453.2


IN WITNESS WHEREOF, each of the parties has caused this Assignment Agreement to be executed in the manner appropriate to each.

VIACOR, INC.

By: _____

Its: _____

MEDTRONIC, INC.

By:  _____

Its: _____

EXHIBIT A

U.S. Patent No. 6692513

U.S. Patent No. 6769434

U.S. Patent Application Publication No. 20040034380

U.S. Patent Application Publication No. 20020095166

U.S. Patent Application Publication No. 2002005577

U.S. Patent Application Publication No. 20040044406

U.S. Patent Application Publication No. 20020138044

U.S. Patent Application Publication No. 20020042651A; Method And apparatus for Performing a Procedure on a Cardiac Valve.

U.S. Patent Application Publication No. 200200951A1; Apparatus and Method for Replacing Aortic Valve.

U.S. Patent Application Serial No. 09/700,167; Cardiac Valve Procedure Methods and Devices.

U.S. Patent Application Serial No. 10/014,699; Intracardiovascular Access (ICVA) System.

U.S. Patent Application Serial No. 10/713,386

U.S. Patent Application Serial No. 10/894,677

U.S. Patent Application Serial No. 10/895,272

PCT Patent Application Publication No. WO 03088873

PCT Patent Application Publication No. WO 04043293

PCT Patent Application Publication No. WO 0308809

PCT Patent Application Publication No. WO 00/44313; Cardiac Valve Procedure Methods and Devices.

PCT Patent Application Publication No. WO 02/01999; Method And apparatus for Performing a Procedure on a Cardiac Valve.

PCT Patent Application Publication No. WO 02/47539; Apparatus and Method for Replacing Aortic Valve.

PCT Patent Application Serial No. US00 02126; Intracardiovascular Access (ICVA) System.

U.S. Provisional Patent Application entitled Cardiac Valve Procedures and Mechanisms.

U.S. Provisional Patent Application entitled Fixation Band for Affixing a Prosthetic Valve to Tissue.

U.S. Provisional Patent Application entitled Method and Apparatus for Resecting and Replacing an Aortic Valve (filed April 16, 2002).

U.S. Provisional Patent Application entitled Method and Apparatus for Resecting and Replacing an Aortic Valve (filed Nov 13, 2002).